

REMARKS/AMENDMENTS

This paper addresses the issues raised in the Office Action mailed August 24, 2005. This amendment is submitted in compliance with the guidelines of the revised amendment practice. See 1267 Off. Gazette 106.

Claims 1-19 are currently pending. In the Office Action, the Examiner provisionally rejected Claims 1-19 under the judicially created doctrine of obviousness-type double patenting over claims 1-20 of copending Application No. 10/655,494; rejected Claims 1-2, 5 and 13 under 35 U.S.C. § 102(e) as being anticipated by Miyata (U.S. Publication No. 2005/0105747) and rejected Claims 3-5, 7-9 and 14-19 under 35 U.S.C. § 103(a) as obvious in view of Miyata.

DOUBLE PATENTING

In the Office Action, Claims 1-19 were provisionally rejected as under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/655,494. A terminal disclaimer in compliance with 37 CFR 1.321) will be filed under separate cover. Reconsideration of this provisional rejection is respectfully requested.

CLAIMS REJECTION - 35 U.S.C. § 102(B)

Claims 1-2, 5 and 13 were rejected under the provisions of 35 U.S.C. § 102(e) as being anticipated by Miyata (U.S. Publication No. 2005/0105747). As set out below, it is respectfully submitted that this reference does not anticipate the cited claims.

Miyata discloses a sound card apparatus which produces sound only when the entire apparatus vibrates. (See paragraphs 0007-0008). Thus, this reference discloses an apparatus where all its aspects are required to produce sound. In other words, if the substrate did not vibrate, there would be no sound. This reference does not disclose the inclusion of stand alone speakers or any other device that produces sound absent the entire substrate vibrating.

The cited claims specifically include one or more planar speakers located within a frame. There is no special meaning attached to the term speaker. It means a device that can produce vibrations, as thus, sound. There is no requirement or limitation that includes having the frame be an active part of the sound generation. Accordingly, reconsideration is respectfully requested.

CLAIMS REJECTION - 35 U.S.C. § 103(A)

Claims 3-4, 6-9 and 14-19 were rejected under the provisions of 35 U.S.C. 103(a) as being made obvious by Miyata. As set out below, it is respectfully submitted that Miyata does not render the cited claims unpatentable.

It is first stated that all the cited claims include the same limitation of having one or more speakers. For the reasons stated above, it is submitted that this reference does not teach the use of a standard speaker and thus does not render the cited claims obvious.

In the Office Action, it is acknowledged that while Miyata discloses a card sound device which requires the entire apparatus to vibrate in order to produce sounds, fails to teach having at least one ribbon speaker (claim 3); at least one distributed mode loudspeaker (claim 4); removable grills over any speaker (claim 7); frames made from extruded aluminum (claim 8); having a planar speaker processing circuit (claims 9, 14, and 19); a conventional speaker (claim 10); speakers being mounted on the right and left (claims 11 and 12); and a frame of removable wood trim (claim 15-16). In each case where there was an element not taught by Miyata, the Office Action alleged that the missing element was known in the prior art without citing a reference. Applicant respectfully traverses the rejection and requires citation of a reference for any element not described in Miyata. It is difficult if not impossible to comment on a proposed combination where there is no art cited for the acknowledged claim elements not in the reference cited.

The Federal circuit has recently commented on this practice. The most recent case on the combination of references without adequate foundation is *In re Zurko* 59 USPQ 2d 1693 (Fed. Cir. 2001) where the Federal Circuit reversed the Board of Appeals upholding of a rejection, where the rejection was based upon the "basic knowledge" or "common sense" of a person of ordinary skill in the art. Specifically, the Court held that any such rejection must be supported by concrete evidence in the record. As the Court discussed in reversing the Board:

“With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather the Board must point to some concrete evidence in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise.”

The entire 35 U.S.C. 103 rejection is based on unsupported statements of what is in the knowledge of such a person without citation to anything other than a single reference, which does not even disclose, let alone suggest the claimed features of the invention. For each of these reasons, Applicant respectfully requests withdrawal of the rejection and passage to issue.

Regarding any potential rejection based upon combination of Miyata with any prior art that shows missing elements of the claimed invention it is respectfully urged that the references must suggest the combination, disregarding disclosures in the references, which diverge from or teach away from the claimed invention, and picking and choosing from the references only so much as will support a rejection is reversible error. In *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (CAFC 1983) it was held:

“In its consideration of the prior art, however, the district court erred...in considering the references in less than their entireties, i.e., "in disregarding disclosures in the references that diverge from and teach away from the invention at hand.”

Similarly, in *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 231 USPQ 416, 419 (CAFC 1986) it was held:

“It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art”.

In view of the above, all of the Office Action's characterizations of the teachings of the applied references are respectfully traversed. With the above rules of law in mind, the reference applied by the Office Action in rejecting claims 5-18 and 20, Miyata and the uncited art, does not teach all of the claimed invention. They are unrelated to the questions sought to be solved by the claimed invention.

It is urged in the rejection that it would be obvious for a person of average skill in the art to substitute portions of the uncited devices into the device of Nishida. The applicable legal standards for combining references were reiterated by the Patent Office Board of Appeals in *Ex Parte Skinner*, 2 USPQ 2d 1788, 1790 (BPAI 1987). There the Board reversed the examiner's combination of references, saying:

“To properly combine the references to reach the conclusion that the subject matter of claims 20 and 21 would have been obvious, "case law requires that there must have been some

teaching, suggestion, or inference in either reference, or both, or knowledge generally available to one of ordinary skill in the relevant art, which would have led one of ordinary skill in the art to combine the relevant teachings of the references.”

Also pertinent is the case of *Panduit Corp. v. Dennison Mfg Co.*, 227 USPQ 337, 343 (CAFC 1985) where the Court stated:


“It is impermissible to first ascertain factually what appellants did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants' invention from such prior art.”

There is no suggestion in Miyata or the uncited art that their teachings be combined; nor do they provide any motivation or reason for being combined. The Office Action does not even attempt to present any possible reason why a person of ordinary skill in the art would combine these references except for language in the claim sought to be rejected. The claimed inventions specification is the sole source of any suggestion to use manipulate animation by deconstruction of drawing objects. Any such combination thus must be regarded as a result of hindsight gleamed from the application being examined.

CONCLUSION

Based on the above, the Applicant respectfully submits all the claims are in condition for allowance and such allowance is hereby respectfully requested. All amendments have been specifically added to clarify the antecedent basis of the claims themselves and not to avoid a reference. Accordingly, the Applicant respectfully asserts that no claims have been narrowed within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd.*, 234 F.3d 558 (Fed. Cir. November 29, 2000). Therefore, reconsideration of the present application, in light of these remarks, is respectfully requested. It is believed that no additional fees are required with the filing of this paper. In the event, however, fees are due with this paper, please contact the undersigned.

Respectfully submitted,


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